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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,518	06/11/2001	Paula F. Delano	END920010011US1	4253
23550 7590 03/07/2007 HOFFMAN WARNICK & D'ALESSANDRO, LLC 75 STATE STREET 14TH FLOOR ALBANY, NY 12207			EXAMINER TARAE, CATHERINE MICHELLE	
			ART UNIT	PAPER NUMBER
			3623	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/07/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/878,518

Applicant(s)

DELANO ET AL.

Examiner

C: Michelle Tarae

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 13, 2006 has been entered.

Claims 1, 7, 13, 16, 22, 26 and 31 have been amended. Claims 1-35 are now pending in this application.

Response to Amendment

2. Applicant's amendments to claims 1, 7, 13, 16, 22, 26 and 31 are acknowledged.

Response to Arguments

3. Applicant's arguments are moot in view of the new grounds of rejections provided below.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puri (U.S. 6,064,982) and Barritz et al. (U.S. 6,938,027).

As per claim 1, Puri discloses a computer-implemented method for analyzing software application needs of a business entity to determine whether to remove an entity software application, comprising the steps of:

formulating a set of questions related to the entity software application based on a business strategy corresponding to the business entity, wherein the set of questions are tailored to assess the software application needs of the business entity and to measure how well the entity software application is meeting the software application needs (col. 1, lines 33-35 and 47-53; col. 3, lines 32-34; col. 5, lines 1-15 and 26-30; Figure 4; The system takes the business entity through a series of interactive questions to learn more about the application needs of the business entity. Item 52 in Figure 4 lists specific software application needs such as information publishing and electronic commerce. The business entity identifies its needs by checking the boxes (item 51 in Figure 4) most relevant to its needs. The needs assessment process measures how well the entity software application is meeting the software application needs of the business entity by recommending products that will actually meet the business entity's software application needs. In other words, a product is recommended only if it is determined in the needs assessment that the business entity needs the product, which means the business entity does not have a current product that meets that particular software application need (i.e., a current software application is not meeting the software application needs of the business entity well).);

receiving entity responses to the set of questions (col. 5, lines 3-8; Figures 4-6; Entity responses are received through an interactive interface.).

Puri does not expressly disclose inventorying a set of entity software applications that are *currently used by the business entity*. Although Puri does disclose a needs assessment through which a business entity identifies technology areas in which they desire software applications (see Figure 4). By identifying technology needs, such as a desire to enhance a web site (statement 4 in Figure 4), a business entity is identifying the hardware and software they are currently using (i.e., in order to have a functioning web site to begin with, certain hardware and software applications must be in use (such as web servers)). Barritz et al. discloses products that exist that inventory software products that have been installed on a computer system (col. 2, lines 47-55). Barritz et al. also discloses a product for monitoring software products installed on a computer system and their usage (col. 6, lines 17-25). Puri and Barritz et al. are analogous in that each is concerned with providing products/software applications to entities that entities will use based on their products/software applications needs/requirements. Identifying the software applications that a business entity is currently using, while also receiving their technology needs, provides a recommendation tool such as that of Puri with more comprehensive data to conduct a needs analysis and product recommendation. For example, if a business entity identifies a particular publishing application that it is currently using while also identifying publishing as a technology area that needs improvement, the recommendation tool would not recommend the publishing application that the business entity is currently using (at least not without some modification) as it

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obviously is not sufficient for the business entity's needs. Thus, at the time of the invention, it would have been obvious to a person of ordinary skill in the art for the system of Puri to inventory a set of entity software applications that are currently used by the business entity as doing so provides the recommendation tool with more comprehensive data with which to conduct a needs assessment, thereby enhancing the analysis and ultimate product recommendation performed by the recommendation tool.

Puri does not expressly disclose determining, based on entity responses, whether to remove the entity software application. Barritz et al. discloses determining, based on entity responses, whether to remove the entity software application (col. 1, lines 32-35 and 40-46; col. 6, lines 25-29). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Puri to determine whether to remove an entity software application because doing so aids the entity in being more cost efficient and making better decisions about products it will use, as removing an entity software application is typically done when a software application is considered obsolete or underused (see Barritz et al., col. 2, lines 8-12; col. 6, lines 25-29).

As per claim 2, Puri discloses the method of claim 1, further comprising the step of weighting possible responses to the set of questions based on the business strategy (col. 5, lines 3-15; Figure 4; By allowing an entity to identify needs that are important for its business, the system is in essence weighting the responses. If a particular need is identified, the system guides the entity to answer more questions relating to that need, thereby emphasizing the need.).

As per claim 3, Puri does not expressly disclose the method of claim 2, wherein the step of weighting responses comprises the step of assigning a value for each possible response to the set of questions. However, as discussed in claim 2, by allowing an entity to identify needs that are important for its business and then asking additional questions related to those needs, Puri is emphasizing the identified needs and thus, weighting the responses (col. 5, lines 3-15; Figure 4). Assigning a value to a weight is old and well known in the art. Thus, at the time of the invention, it would have been obvious to a person of ordinary skill in the art for the system of Puri to assign values to the needs identified by an entity because doing so allows the system to associate each identified need with a specific worth, providing the system with more accurate and quantifiable data with which to conduct the needs assessment, which is a goal of the Puri system (col. 6, lines 43-46).

As per claim 4, Puri discloses the method of claim 1, further comprising the step of analyzing the received responses to make a set of recommendations (col. 6, lines 5-13 and 43-46; The system provides recommendations to the entity based on the application needs assessment. The application needs assessment includes an interactive tool through which the entity selects from a predetermined question/answer session.).

As per claim 5, Puri discloses the method of claim 1, further comprising the step of generating a report based on the received entity responses (Figure 9).

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As per claim 6, Puri discloses the method of claim 1, wherein the entity software applications are grouped by business process (item 42 in Figure 4 shows a business process grouping of the needs to be identified by the entity).

Claims 7-35 recite substantially similar subject matter as claims 1-6 above. Therefore, claims 7-35 are rejected on the same basis as claims 1-6.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Brown et al. (U.S. 6,385,652) discusses a customer access solutions architecture;
- Breslin (U.S. 5,321,610) discusses a system for implementing application software;
- D'Souza (U.S. 6,453,468) discusses upgrading software programs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Tarae whose telephone number is 571-272-6727. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 571-272-6729.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



C. Michelle Tarae
Primary Patent Examiner
Art Unit 3623

March 1, 2007